

REMARKS

Applicant has amended independent claims 1-3 in this response to put all pending claims in condition for allowance. Applicant submits that amended independent claims 1-3 pending in the above-identified patent application, as well as pending dependent claims 4-21 and 23-24, which depend from claims 1-3, are now in allowable form. Claims 22 and 25 have been canceled. Reconsideration and allowance of all pending claims are respectfully requested. New matter has not been added by way of these amendments as support for the amendments can be found in the specification as filed.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter, as recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing this response.

At page 2 of the Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has canceled claim 25 with the amendments herein. Accordingly, the Examiner is respectfully requested to withdraw the rejection.

The § 102 Rejections

At page 2 of the Office Action, the Examiner rejected claims 1-2, 5-13, 18, and 23-24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,873,882 to Straub. As amended herein, Applicant respectfully traverses the rejections.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631; 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236; 9 USPQ2d 1913, 1920 (Fed.Cir. 1989).

As amended herein, independent claims 1-2 of the present invention incorporate the features of claim 22, and require: a flexible tube surrounding the transport screw, connected to the working head and intended for removing the removable material or detached thrombi and emboli fragments wherein the flexible tube comprises a proximal part, the proximal part having a proximal end and a distal end, the proximal end comprising a plastic tube and the distal end comprising a metallic helical spring surrounded by a thin-walled elastic plastic sheath. Because

the Examiner did not allege that the flexible tube having a distal part comprising a metallic helical spring, as recited above, is disclosed or suggested by the '882 Straub reference, Applicant acknowledges this deficiency. Accordingly, no anticipation of independent claims 1-2 under 35 U.S.C. § 102 can be maintained because no single prior art reference sets forth each and every element as arranged in the presently amended claims of the instant invention by Applicant.

The § 103 Rejections

At page 6 of the Office Action, the Examiner rejected claims 3-4, 14 and 25 under 35 U.S.C. § 103(a) as being obvious over the '882 Straub reference in view of U.S. Pat. No. 5,312,425 to Evans. At page 11, the Examiner rejected claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over the '882 Straub reference in view of U.S. Pat. No. 6,217,565 to Cohen; and at page 12 of the Office Action, the Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being obvious over the '882 Straub reference in view of U.S. Pat. No. 4,705,511 to Kocak.

Turning first to the rejection of claim 22, based on the '882 Straub reference in view of Kocak, the Examiner argues that Straub discloses a tube comprising a proximal part that comprises a plastic tube, and that Kocak discloses a distal part comprising a metallic helical spring having a thin-walled elastic plastic sheath, alleging that it would be obvious to one of ordinary skill in the art to modify the invention of Straub with the helical metallic spring and sheath of Kocak because "[d]oing so would provide a flexible support structure for the tube." In view of the following, Applicant respectfully traverses the rejection.

Under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the

claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int’l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP § 2141.

Applicant submits that the combination of the proximal part comprising a plastic tube as disclosed in the ‘882 Straub reference with the helical coiled spring as disclosed in Kocak does not result in Applicant’s claim 22, which requires a tube comprising a proximal part comprising a plastic tube and a distal part comprising a metallic helical spring having a thin-walled elastic plastic sheath. Specifically, the Kocak reference discloses, at lines 3-12 of the Abstract, “a helical coiled spring . . . and a thin cylindrical wall prepared from a protective coating . . . the coating composition comprising a thermoplastic polymeric material dissolved in a solvent solution.” Therefore, Kocak discloses only a coated spring. The ‘882 Straub reference discloses, for example, a plastic tubular sheath into the stator. (See column 4, line 58 of the ‘882 Straub reference.)

By way of distinction, Applicant’s claim 22 comprises, for example, a flexible tube, of which part is a hollow plastic tube, part a relatively thinner sheath containing reinforcements. In at least one example, Applicant discloses “a customary thicker plastic tube,” wherein the relatively stiffer proximal region of the tube may be joined with the relatively flexible distal portion. (See paragraphs [0070]-[0072] of Applicant’s application.) Therefore, at least one embodiment of the flexible tube comprises two components – a proximal part, the tube, and a distal part, the plastic sheath. Applicant’s flexible tube, accordingly, does not consist only of a plastic sheath. Further, for example, Applicant contemplates connecting the two parts by shrinkage or adhesive bonding, or “with a thin, closely fitting covering.” (See Paragraph [0072] of Applicant’s application.) This is unlike the structure disclosed in Kocak, which is only a coated helical spring. There is no mention of two components being joined. There is likewise no mention of two components of relatively stiff and flexible components being joined in the ‘882 Straub reference. Therefore, if one of ordinary skill in the art were to combine the structures disclosed in the Straub and Kocak references, he would not arrive at Applicant’s claim

22 and the Examiner has not established a *prima facie* case of obviousness. Applicant's claim 22 and any claim reciting its features, is therefore not obvious over the '882 Straub reference in view of Kocak, as alleged by the Examiner. Accordingly, the Examiner is respectfully requested to withdraw the rejection.

Additional evidence that the combination of the features recited in the '882 Straub and Kocak references does not result in Applicant's claim 22 follows. One example as to why Applicant designed the flexible tube is so that it could be connected to the working head so as to provide resistance to tension and pressure and yet remain "particularly flexible . . . [to] be advanced and withdrawn . . . around even narrow curves." (See paragraphs [0037] and [0041] of Applicant's application.)

In contrast to the structures recited in the Kocak reference, Applicant's as-filed specification teaches, for example and not by way of limitation, the use of a plastic tube at the proximal part, and a sheath covered reinforcement at the distal part. Applicant discloses "pure plastic" in the proximal part, not a coating. (See paragraph [0041] of Applicant's application). Plastic tubes are typically extruded structures, although they may be injection molded, and in any case, one cannot employ a coating/dipping/spraying process to form a hollow, cylindrical structure, unless some other structure is present to be coated, dipped, or sprayed. Because Applicant's tube is partially unreinforced, "pure plastic" and cylindrical, it cannot be formed via coating, spraying or dipping. The Kocak reference refers to dipping or spraying the spring in liquid coatings formed from solutions, as recited at column 2, lines 45-50, lines 55-60, column 3, lines 10-20, column 5, lines 15-20, and column 6, lines 5-10. Further still, the Kocak reference teaches away from using the extrusion process as recited at column 4, lines 35-40. Therefore, Applicant's claim 22 is fundamentally different than the structure disclosed in Kocak or any combination of features with the '882 Straub reference.

Accordingly, the '882 Straub reference does not disclose all elements of Applicant's present claims, and the missing elements are not supplied nor suggested by the Kocak reference. With the foregoing in view, no rejection based on the '882 Straub and Kocak references can be maintained, and the Examiner is respectfully requested to withdraw the rejection.

As mentioned above, Applicant amended claim 3 to incorporate the features of claim 22. Accordingly, claim 3 requires: a flexible tube surrounding the transport screw, connected to the working head and intended for removing the removable material or detached thrombi and emboli fragments wherein the flexible tube comprises a proximal part, the proximal part having a proximal end and a distal end, the proximal end comprising a plastic tube and the distal end comprising a metallic helical spring surrounded by a thin-walled elastic plastic sheath. Because the Examiner did not allege that the flexible tube having a distal part comprising a metallic helical spring, as recited above, is disclosed or suggested by the '882 Straub or Evans references, the §103(a) rejection of independent claim 3, and claim 4, which depends therefrom, cannot be properly based on those disclosures. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 3 and 4.

Claim 14, which the Examiner has rejected as unpatentable over the '882 Straub reference in view of Evans, is similarly traversed. Claim 14 depends from independent claim 1, which has been amended herein as recited above. The Examiner does not allege that either the '882 Straub or Evans reference discloses or suggests a flexible tube surrounding the transport screw, connected to the working head and intended for removing the removable material or detached thrombi and emboli fragments wherein the flexible tube comprises a proximal part, the proximal part having a proximal end and a distal end, the proximal end comprising a plastic tube and the distal end comprising a metallic helical spring surrounded by a thin-walled elastic plastic sheath. Therefore, because each and every limitation of amended claim 1 is not found in either the '882 Straub or Evans reference, no rejection of claim 14 can be maintained; and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claims 19-21 under 35 U.S.C. § 103(a) as being unpatentable over the '882 Straub reference in view of U.S. Pat. No. 6,217,565 to Cohen. Claims 19-21 ultimately depend from independent claim 1. As mentioned above, claim 1 has been amended. The Examiner does not allege that the Cohen reference discloses or suggests a flexible tube surrounding the transport screw, connected to the working head and intended for removing the removable material or detached thrombi and emboli fragments wherein the flexible tube comprises a proximal part, the proximal part having a proximal end and a distal end, the proximal end comprising a plastic tube and the distal end comprising a metallic helical spring

surrounded by a thin-walled elastic plastic sheath. Accordingly, the rejections are traversed as above because no rejection of claim 12 can be maintained; and the Examiner is respectfully requested to withdraw the rejection.

In view of the foregoing amendments and arguments, Applicant submits that independent claim 1, and claims 5-21 and 23-24 which depend therefrom, are now in form for allowance. Similarly, independent claim 2, and independent claim 3 from which dependent claim 4 depends, are in form for allowance. Therefore, Applicant submits that all of the claims presently pending in the application are in condition for allowance, and the Examiner is respectfully requested to withdraw all rejections for the pending claims.

If the Examiner believes that there are unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Matthew Dernier, Esq., at (732) 634-7634 so that appropriate arrangements can be made for the resolution of such issues as expeditiously as possible.

Early and favorable action is earnestly solicited. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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